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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,080	12/01/2004	Kazuhiko Kosuge	2004-1271A	1359

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/509,080	Applicant(s) KOSUGE ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 6 and 13 to 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 6, 13 to 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/3/06</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 5, 6 and 13 to 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The addition of the negative proviso "wherein the solution does not comprise a crosslinking agent" is not supported by the specification. The mere absence of a positive recitation is not basis for an exclusion.

2. Claims 5, 6 and 13 to 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 5 to exclude crosslinking agents. It is unclear what applicants intend by the term "crosslinking agent" or what this embraces. The Examiner makes this point because the compound (2) in claim 6 will inherently undergo crosslinking with the compound (1) in claim 1 by virtue of the condensable OR groups. Since claim 5 excludes crosslinking agents yet includes the compound (2) it is not clear what applicants intend by the term crosslinking agent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6 and 13 to 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naito et al.

The Examiner relies on the rationale of record as the basis for this obviousness rejection. See for instance paragraphs 8 and 9 of the previous office action.

Applicants' traversal is not persuasive. Applicants note that they have excluded the crosslinking agent found in Naito et al. from the claims. However since the crosslink-

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ing agent in Naito et al. meets the formula (2) found in claim 6, this specific compound in Naito et al. is not actually excluded from the claims.

Applicants also refer to a Rule 132 Declaration. This fails to establish any unobviousness for the instant claims because applicants compare fibers made by the claimed process to fibers treated with other prior art compositions. This does not establish any unobviousness over the teachings in Naito et al. Note too that it is unclear if it is the fiber or the specific coating composition that results in the different properties. Furthermore, the single showing within the breadth of the claims cannot be considered representative of the breadth of the claims.

For claims 14 and 15, see column 20, line 15.

5. In the event that claim 5, as amended, does exclude the crosslinking agent in Naito et al., the Examiner makes the following new ground of rejection.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5 and 13 to 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kane et al.

Kane et al. teach phenolic/siloxane polymer compositions. The Examiner notes that the coating composition used in the claimed method is open to the inclusion of a phenolic resin, even if the phenolic resin reacts with the siloxane as shown in reaction #4 on column 18, because the phenolic resin is not a crosslinking agent. However column 3, line 65 and on, discloses that the final product is, in fact, an interpenetrating network of siloxane and phenolic polymer that has little, or no chemical bonding there-between. Particular attention is drawn to Reaction #6 on the bottom of column 18 which shows a coating composition having a compound represented by the formula (1) in claim 1 (see the top of column 19 which shows this compound with a corresponding "n"

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value of 3). Column 13, lines 20 and on, teaches the presence of a organic metal catalyst meeting claims 14 and 15.

These compositions are used to coat pipes. Column 23, line 36 and on, teaches that the pipes can be formed from windings of a filament (i.e. a fiber) formed from Kevlar (polyparaphenylene terephthalamide). Thus the compositions in Kane et al. which include the siloxane as shown in reaction #6 is used to coat a pipe which can be prepared from Kevlar filaments. In this manner the instant claims are fully met by the teachings in Kane et al.

For claim 13, please see column 15, lines 35 and on, which teaches that water need not be present if a silanol functional silicone intermediate (which would correspond to instant compound (1) when R_1 to R_3 is hydrogen) is used.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Margaret S. Moore
Primary Examiner
Art Unit 1712

mgm
6/12/06